

Atty. Dkt. No. 057898-0105

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing reasons which follow. Note that the word "set" is used in the claims and it is intended to mean one or more.

Claims 87-95, 99, 100, and 102-105 were rejected under 35 USC 103 as being unpatentable over Geer (U.S. 5,930,778). This rejection is respectfully traversed and reconsideration thereof is requested.

Independent claim 87 claims a program product that includes computer readable program code for performing a novel and non-obvious group of steps. These claim limitations are to be examined as a whole, including a consideration of all of the claim elements as an operable combination.

One of the steps comprises *"the central site initially transmitting electronic check data and check image data directly or indirectly to a maker bank or to a print site for ultimate delivery in hard copy to the maker bank, with this transmitting step not being through an accounting program in the bank of first deposit."*

The examiner states in her office action that

"Geer does not disclose wherein the transmitting step not being through an accounting program in the bank of first deposit associated therewith. However, employing a central site to handle the deposited checks on behalf of a bank of first deposit is well known in the art. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Geer's to incorporate the feature above for the purpose of providing more efficiency in processing the deposited checks."

This statement by the examiner is wrong as a perusal of Geer will show. Referring to the Summary and Objects of the Invention in Geer, with reference to the only disclosed embodiment teaching to image the paper check and then truncate the paper check at the remote site, it is stated as follows at column 4, line 54- column 5, line 9:

"In one embodiment, electronic scanning means at a first location established by the payee receives the financial instruments, scans and extracts necessary data therefrom including the data of the magnetic ink character recognition (MICR) line of the instrument, adds necessary data such as the amount and a document identification

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number to the electronic information associated with each check, and sends this electronic information to the payee's depository bank for further electronic sorting and processing both with regard to the introduction of the checks into the payment system and the crediting of funds represented by the checks to the payee's account at the bank, as the payee processes the check in its own record of account with the check payor. In this first embodiment, the paper financial instruments are typically imaged (electronically, digitally, optically, on microfilm or disk, or otherwise) for archival storage at the payee's location remote from the payee's depository bank, substantially contemporaneous with the capture of the financial or other information on the instrument. The paper instrument itself may then be disposed of, eliminating the need for any additional mechanical sorting, indorsing or imprinting by either the payee or the payee's depository bank." (Emphasis added.)

See also column 8, lines 9-21 as follows:

In FIG. 1, box 7 indicates the creation of an image of the check for archival storage 8 prior to possible disposition of the paper instrument 9. An image of the physical check is created. This image is preserved and may be reproduced as a copy of the check for purposes of signature comparison, amount verification, etc. if needed. The image may be an optical or electronic gray-scale or color image of the check maintained in archival storage in pixel-by-pixel digital, optical, magnetic, electronic, fully optical or other storage technology from which information can be derived. Alternative storage mechanisms include microfilm, video tape, laser disc or other tape or direct image storage technology. (Emphasis added.)

With respect to the examiner's citations in column 9, see lines 1-4

In FIG. 1, the image 7 is stored at the payee's location in an archival storage facility 8. However, this image of the check may also be transmitted electronically to the bank along with the other information extracted from the check. (Emphasis added.)

See also column 9, lines 11-34 as follows:

The information from the electronic scanning 6 performed at the payee's location is transmitted via a suitable communication link 11 to the depository bank 10. At the depository bank, the appropriate adjustments of the payee's account balances by the depository bank are carried out 13. The payee's account is credited with the appropriate amounts as such are compiled by the payee and the information thereof is received electronically from the payee. The electronic check information is sorted and routed via 14, with appropriate electronic information added thereto to insure proper routing through the payment and clearing system to the appropriate payor bank. Electronic information of the sorted checks transmitted for particular payor banks, the equivalent of a cash letter, is included with each electronic bundle of checks.

The electronic check information as sorted, grouped and annotated 14 by the

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depository bank is sent via an appropriate communication link 15 into the payment system 12. The payment system 12 includes clearing institutions such as the Federal Reserve Banks, correspondent banks, The National Clearinghouse Association (described in United States Letters Pat. No. 5,265,007), the electronic check clearing house organization (described in Stephens et al., supra), and like mechanisms. (Emphasis added.)

From the above, it is clear that Geer teaches the creation of an image of a check for archive purposes, and further teaches that the check image "may also be transmitted," i.e., it is optional, to the bank of first deposit. There is no indication that the check image, if it has optionally been sent to the bank of first deposit, is then sent on to the maker/payor bank. There is no direct teaching by Geer that the optional image of the check is included in the transmission from the bank of first deposit to the payor/maker bank. What this teaching by Geer clearly does indicate is that, with its optional nature, the check image is not used as a part of the presentment process at the maker bank. More importantly, if Geer is misconstrued as providing a teaching of optionally transmitting the check image from the bank of first deposit to the maker/payor bank for archival purposes (which it does not), it is a direct teach-away from the claim element that the accounting programs in the bank of first deposit are to be bypassed in the transmission path from the central site to the maker bank, i.e., the transmitting not being through the accounting programs of the bank of first deposit.

Referring now to the claim 87, the following limitations is present in the claim as a whole:

"the central site initially transmitting electronic check data and check image data directly or indirectly to a maker bank or to a print site for ultimate delivery in hard copy to the maker bank, with this transmitting step not being through an accounting program in the bank of first deposit."

As the examiner states in the office action, this limitation is not met. But it is not only not met by Geer, but Geer directly teaches away from the limitation. The advantage of the limitation is not only significantly reducing delay in the processing by the maker bank, but also the enhancement of security by eliminating the possibility of the insertion of virus', Trojan horses, or other malicious code while the image and attendant data is passing through the computer links and processing of the bank of first deposit.

It is noted that the Examiner has taken official notice that the limitation "employing a central site to handle the deposited checks on behalf of a bank of first deposit is well known in the art. This

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statement is traversed in accordance with MPEP 2144.03 and proof is requested. But with all respect, this is not the limitation in the claim. The limitation reads as recited above. What the examiner must address is whether there is a teaching of a central site that bypasses the bank of first deposit accounting processing and transmits to the maker bank. If the examiner is asserting that the foregoing limitation is "well known in the art," then in accordance with MPEP 2144.03, applicants timely traverse/challenge this official notice statement and request that this point of official notice be supported by a citation to a reference, as set forth by the MPEP Office requirements.

Note that even if the examiner can find a reference teaching a central site (which applicants' do not believe exists), there would be no motivation in one of ordinary skill in the art to combine such a teaching with Geer, because Geer directly teaches away from such a combination/modification, as noted above.

Additionally, as part of the claim as a whole the following limitation is included

*a computer at the central site comparing at least one deposit parameter that is not an account number to an individual customer limit;
sending a notice if the individual customer limit is exceeded.*

The examiner admits as follows: "Geer does not disclose a computer at the central site comprising at least one deposit parameter that is not an account number to an individual customer limit, sending a notice if the customer limit is exceeded, comparing a number of monetary items with a customer monetary limit. However, such features above are well known in the art of processing a check. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Geer's to incorporate the feature above for the purpose of providing more efficiency in processing the deposited checks."

This assertion by the examiner that "such features above are well known in the art of processing a check" is respectfully traversed and in accordance with MPEP 2144.03, applicants timely challenge this official notice statement and request that this point of official notice be supported by a citation to a reference, as set forth by the MPEP Office requirements. Note that claim 87 is a combination claim that must be examined as a whole, and requires a reference that shows a central site operation that not only bypasses the bank of first deposit in its transmission to the maker bank, but also operates by "comparing at least one deposit parameter that is not an account number to an individual customer limit; sending a notice if the individual customer limit is exceeded." There is no discussion or

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suggestion in Geer of a deposit parameter, much less the function of performing a comparison of data to a deposit parameter at a central site that is bypassing the accounting programs of the bank of first deposit in its operations. Applicants note that there is no motivation to modify Geer in such a fashion. If such a function was to be performed by Geer (and there is no disclosure that it is or could be), then it would be performed by the accounting programs at the bank of first deposit. However, use of such accounting programs is specifically excluded.

Thus, a prima facie case of obviousness has not been made out per the MPEP and withdrawal of the rejection is respectfully requested.

Note that the claims 88-94 further define the individual customer limits, as well as unique combinations of customer limits, and are patentable for the reasons stated for claim 87 and also for their additional limitations which are not met by Geer.

Regarding claim 95, it claims

program code for receiving receives electronic deposit data, electronic check data and original check image data for a plurality of different deposit transactions, the checks for each one of the plurality of different deposit transactions to be deposited at a different bank of first deposit; and further comprising program code for sending each one of a plurality of the different deposit transactions to a respective different bank of first deposit.

The examiner cites Geer at column 9, lines 10-13 as teaching this limitation. That Geer language reads as follows:

The information from the electronic scanning 6 performed at the payee's location is transmitted via a suitable communication link 11 to the depository bank 10.

That language say nothing about "the checks for each one of the plurality of different deposit transactions to be deposited at a different bank of first deposit; and further comprising program code for sending each one of a plurality of the different deposit transactions to a respective different bank of first deposit." Geer describes a lock-box operation where a power company or other company that receives large numbers of checks and sends those checks to be deposited in the power company's bank, i.e., the bank of first deposit. The first point is that the power company will have one bank, not multiple banks. Second, if for some reason the power company actually had multiple banks (which it would not), then it would be nonsensical to send the check to the wrong bank of first deposit, so that

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the wrong bank of first deposit could then send the checks to the correct bank of first deposit. Thus, there is no possible motivation for one of ordinary skill in the art to modify Geer to send checks first to one bank of first deposit, where the checks would then be distributed to other banks of first deposit. Thus, this rejection cannot stand.

Regarding claims 100, this claim calls for

determining if a re-presentment of a returned check requires a hard copy of the return check or if the check data image is acceptable for the re-presentment; and if the check image is acceptable, obtaining a reference key associated with an original deposit transaction; and sending directly or indirectly the check image data and the reference key to the maker bank.

Claim 100 relates to representment of returns. Geer discusses returns at column 9, lines 45-50, wherein it states

In the event of dishonor of a check by a payor bank, the process reverses as to the collection of the dishonored check, and this information may be transmitted electronically back through payment system 12 (or by more direct means of reversal) to depository bank 10 for unwinding the transaction and for debiting of the payee's account as to the dishonored check.

There is no reference in this citation to representment that includes sending return check image data, much less making a determination via software, i.e., code in the program product to determine if the a hard copy of the image is required in the representment.

The examiner rejects claims 102 over Geer, but admits that the limitation added by this claim is not disclosed by Geer. "Geer does not disclose determining of endorsement information one of the remote sites for printing on the check is up-to-date; and if the endorsement information at the remote site is not up-to-date, then downloading updated endorsement information from the central site. However, checking and obtaining the up-to-date endorsement information is well known in the art of processing checks. Therefore, it would have been obvious to include that feature with Geer's for the purpose of ensuring of endorsement information is an up-to-date endorsement information."

Note that claim 102 depends, not from claim 87, but rather from claim 101, which is rejected over the combination of Geer in view of Campbell (5,373,550). Claim 102 must be examined as a whole, i.e., in combination with the limitations of claims 87 and 101, which has not been done. Regarding claim 102, the statement by the examiner that this limitation regarding determining via the

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program product computer code whether that the endorsement information at the remote cite is up-to-date, and if not, then downloading the up-to-date information is obvious is timely traversed. It is requested that the examiner substantiate this statement per MPEP 2144.03 with prior art disclosing this limitation. This is the third request.

The explanation above regarding claim 87 apply equally to claim 104 in system format and claim 105 in method format.

Regarding claim 101 that relates to multiple remote sites, the examiner cites Geer at column 7, lines 4-25. However, as the examiner states, Geer does not disclose "endorsing and/or voiding the original one or more checks to obtain endorsed and voided checks;" or "creating an image of each of a plurality of the endorsed and/or voided checks to obtain endorsed and/or voided check image data;" or "electronically associating the electronic deposit data, the electronic check data and the original check image data and the endorsed and/or voided check image data;" or "transmitting the electronically associated electronic check data and the original check image data and/or the endorsed and/or voided check image to the central site." Campbell is stated to disclose these limitations, citing column 2, lines 39-43, which read as follows:

For example, the sending institution 14 may be a payor bank and the receiving institution may be a bank of first deposit which are involved in a processes of returning a check dishonored by institution 14 to the institution 16. Alternatively, the sending institution 14 may be a bank of first deposit which is in the process of forwarding checks to an institution 16 which is acting as a payor bank.

However, Campbell discloses creating images for transmission between a payor bank and a bank of first deposit. See the lines above cited by the examiner. There is no disclosure of the concept of a remote site that is not a bank of first deposit or a payor bank creating an image of an endorsed and/or voided check at the point of deposit, i.e., the remote site, and electronically associating that endorsed and/or voided check image data to original check image data. Thus, the rejection of this claim cannot stand.

To repeat the foregoing, the Examiner has taken official notice of a number of limitations. In accordance with MPEP 2144.03, applicants traverse/challenge these official notice statements and request that each point of official notice be supported by a citation to a reference, as set forth by the MPEP Office requirements.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

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The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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